

BS01378

U.S. Application No. 10/017,630 Examiner OUELLETTE, Art Unit 3629
Submission of Amendment with RCE in Response to October 4, 2005 Final Office Action

REMARKS

In response to the final office Action dated October 4, 2005, the Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

The United States Patent and Trademark Office (the "Office") rejected claim 47 for indefiniteness. Claim 21 was rejected for claiming non-statutory subject matter. Claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* Claims 26, 31, 37, 45-47, and 49 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Hendricks* in view of U.S. Patent 6,202,210 to Ludtke *et al.* The Assignee shows, however, that the pending claims are neither anticipated nor obviated by the cited documents. Because neither *Hendricks* nor *Ludtke* teach or suggest all the features of the pending claims, the pending claims must distinguish over the cited documents.

Rejection of Claim 47

The Office rejected claim 47 for indefiniteness. Claim 47 mistakenly depended from claim 21. Claim 47, however, has been amended to correctly depend from claim 46. Examiner Ouellette is thanked for noting mistake.

Rejection of Claim 21 Under 35 U.S.C. § 101

Claim 21 was rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter. Claim 21, however, has been amended and conforms to the patent laws.

Rejection of Claims Under 35 U.S.C. § 102 (b)

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Claims 21-25, 27-30, 32-36, 38-44, 48, and 50-53 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,463,585 to Hendricks *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, all the pending claims are patentably distinguishable over *Hendricks*. Because *Hendricks* fails to teach every feature recited in the claims, the reference to *Hendricks* cannot anticipate. The 35 U.S.C. § 102 (b) rejection must, therefore, be removed.

Hendricks does not anticipate the independent claims. All the independent claims recite features for "receiving subscriber actions from a subscriber-action database, the subscriber-action database storing information related to buttons pushed by a subscriber at a remote control while viewing content." Those subscriber actions are processed, along with content received from a local content database and content received from a national content database, "to predict future buttons pushed by the subscriber." Support for such features may be found at least at paragraph [0019] of U.S. Application 10/017,742, filed December 14, 2001 and entitled "System and Method For Utilizing Television Viewing Patterns," which was incorporated by reference into this application. A "clean" version of independent claim 21 is reproduced below, and all the other independent claims recite similar features.

21. (Currently Amended) A processor-implemented method for predicting content, comprising:

receiving content from a local content database;

receiving content from a national content database;

receiving subscriber actions from a subscriber-action database, the subscriber-action database storing information related to buttons pushed by a subscriber at a remote control while viewing content; and

processing the content received from the local content database, the content received from the national content database, and the subscriber actions to predict future buttons pushed by the subscriber.

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No where does *Hendricks* teach or suggest such features. *Hendricks* completely fails to teach or suggest “storing information related to buttons pushed by a subscriber at a remote control while viewing content.” *Hendricks* completely fails to teach or suggest “predict[ing] future buttons pushed by the subscriber.” Because *Hendricks* is completely silent to such features, the patent to *Hendricks et al.* cannot anticipate the pending claims. The § 102 (e) rejection of claims 21-53 must be removed.

Rejection of Claims Under 35 U.S.C. § 103 (a)

Claims 26, 31, 37, 45-47, and 49 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Hendricks* in view of U.S. Patent 6,202,210 to *Ludtke et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”). The proposed combination of *Hendricks* and *Ludtke*, however, still fails to teach or suggest all the features of claims 26, 31, 37, 45-47, and 49. Examiner Ouellette is then required to remove the rejection.

Claims 26, 31, 37, 45-47, and 49 are not obvious in view of *Hendricks* and *Ludtke*. These claims are all dependent upon their respective base claim and, thus, incorporate the same distinguishing features. No where, for example, do *Hendricks* and *Ludtke* teach or suggest “storing information related to buttons pushed by a subscriber at a remote control while viewing content.” The proposed combination of *Hendricks* and *Ludtke* also completely fails to teach or suggest “predict[ing] future buttons pushed by the subscriber.” One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Hendricks* and *Ludtke* to obviate claims 26, 31, 37, 45-47, and 49. Because the proposed combination of *Hendricks* and *Ludtke*

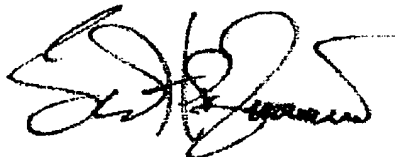
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does not teach or suggest all the claimed features, the § 103 rejection of these claims must be removed.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

Scott P. Zimmerman
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